

## REMARKS

Claims 4-6 have been added. Support for these additional claims can be found on pages 3 and 6 of the Specification. Claims 1-6 remain in this application. In view of the above amendments and the following remarks, reconsideration of the office action is respectfully requested.

### Claim Rejections Under Section 103

Claims 1-3 have been rejected under 35 U.S.C. §103 as being unpatentable over Schermacher et. al. (6,719,452) in view of Crozer (5,116,408). The Examiner states that it would have been obvious to one of ordinary skill in the art to provide a method as disclosed in the '452 patent in verification of a property of a wood stain since the wood stain disclosed in '452 possesses adequate transparency, can be formulated in a wide color selection, and reproducible from batch to batch. Applicant respectfully traverses this rejection.

Schermacher discloses a standard procedure of measuring and matching tints, whereby an aliquot of a transparent tint is blended with a standard white paint, sprayed onto panels, dried and the measuring one or more color properties of the dried coating using a spectrophotometer or calorimeter, and comparing with the standard. In Schermacher, the process is particularly directed to transparent tint products, which are significantly different from the stains in the present invention. Schermacher does not disclose or suggest a method of verifying properties of a transparent wood stain.

Crozer discloses wood stains and the variety of such stains ranging from transparent to opaque. Crozer teaches in detail the chemical compositions of water-based and oil-based wood stains. The combination of Schermacher and Crozer does not cure Schermacher's failure to provide

a motivation to use colorants for color matching or verifying other properties of wood, as in Applicant's invention. The object of Schermacher is for color matching transparent tints used for high performance metallic coatings for automobile and truck exteriors, paints, printing inks, ink jet inks and other colored products using transparent tints. Both Schermacher and Crozer are silent regarding the verification of color and other important properties of semi-transparent wood stains. Wood stains generally comprise an acrylic dispersion with a translucent or transparent colorant. A colorant is generally any substance that imparts color to another material or mixture. The Applicant utilizes a colorant such as an organic or inorganic pigment, to determine color matching and other properties of the wood stains. Examples of organic pigments include phthalocyanine, lithos, toluidine and para red. Examples of inorganic pigments include the metal oxides of iron, titanium, zinc, cobalt, and chrome. Generally, such pigments are added to coatings at a point of purchase to produce desired paint colors. In Applicants' invention, such pigments are added directly into the wood stain for measuring color and color strength properties. Applicant's invention does not utilize a white paint as described in Schermacher. In fact, Schermacher describes utilizing the white paint to calculate the quantities of shading colorants and clear binder required to correct the batch for color and strength. Applicant does not teach the use of a white paint, but of utilizing any colorant for determining color match and color strength properties. The particular features of the present invention are not taught or in any way suggested by the cited references, taken individually or in combination. The combination of Schermacher and Crozer neither disclose nor suggest Applicants' invention. Accordingly, there is no motivation to combine the product of Crozer with the method of Schermacher to provide the method of Applicant's invention for semi-transparent wood stains.

Applicant respectfully submits that in rejecting the claims of the present application over

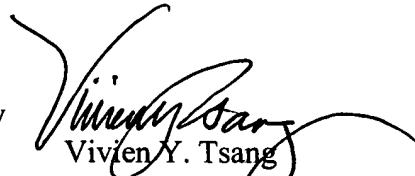
Schermacher or Crozer, the Examiner has improperly ignored the key color development element and other elements of the present invention, and has thus failed to consider the claimed invention as a whole. *Litton Industrial Products, Inc. v. Solid State Systems Corp.*, 755 F.2d 158, 225 USPQ 34 (Fed. Cir. 1985). It is not enough that the Examiner present references that contain assorted features of the invention; rather the Examiner has the burden to show why it would appear that the references would have been combined. Absent some teaching, suggestion, or incentive supporting the combination, obviousness cannot be established by merely combining the teachings of the prior art to produce the claimed invention. Applicant contends there is no teaching, suggestion, nor incentive to combine the teachings of the cited references to show Applicant's claimed invention. It is equally well established that the prior art must provide a motivation or reason for one skilled in the art, without the benefit of Applicant's specification, to make the necessary changes in the reference. Teachings of the references may only be combined if there is some suggestion or incentive to do so. *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). The Applicants' method for semi-transparent wood stains is fundamentally different from the teachings of Schermacher and Crozer. One skilled in the art would not have an incentive to combine the teachings of Schermacher and Crozer to solve the problems associated with semi-transparent wood stains. This ignorance would, in turn, preclude practice of the invention covered by claims 1-6 and hence deprive the art of the beneficial and advantageous results which flow therefrom. The Examiner's combination of Schermacher and Crozer cannot, therefore, support a rejection of Applicants' claims based on obviousness. Accordingly, it is not possible for Schermacher and Crozer to provide a basis for modifying any art to arrive at the invention of claims 1-6 or to suggest its advantageous results. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

Claims 4-6 have been added. Claims 1-6 remain in this application. Applicants respectfully requests the Examiner to consider the above remarks and for the reasons stated above, allow the remaining claims in this application.

Respectfully submitted,

THOMAS J. SKIERSKI, et. al.

By

  
Vivien Y. Tsang  
Attorney for Applicants  
Reg. No. 40,209

August 22, 2005  
The Sherwin-Williams Company  
101 Prospect Avenue, N.W.  
1100 Midland Bldg - Legal Dept  
Cleveland, Ohio 44115  
(216) 566-2487